

REMARKS

Claims 1-31, 33-61 and 63-84 are pending in this matter.

Claims 1, 11, 23, 36, 49, 63, 73 and 74 are independent.

Background

Applicants filed an Amendment dated May 4, 2004. A Final Office Action was issued on September 20, 2004. In response thereto, Applicants filed a Request for Continued Examination (“RCE”) addressing the grounds for rejection in that Final Office Action. A Non-Final Office Action dated January 9, 2005 was issued in the above-identified application in response to Applicants’ RCE and Reply.

Rejection Under 35 U.S.C. § 103(a)

In the Office Action, claims 1-2, 4-9, 11-12, 14, 16-21, 23, 30, 36-37, 39, 41-43, 45, 47-49, 56, 63-71, 73-75 and 77-83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,954,798 (“Shelton”) in view of U.S. Publication No. 2002/0198941 (“Gavrilescu”). Applicants respectfully traverse this rejection based on the following reasons.

Applicants’ Amendment dated May 4, 2004, amended each of independent claims 1, 11, 23, 36, 49, 63, 73 and 74 to include the following limitation:

wherein the first script and the first control and the second script and the second control are independent from Web pages that are displayed on the first computer and the second computer

or a limitation substantially similar thereto. Applicants argued that the addition of that limitation overcame the Examiner's rejection of all claims under 35 U.S.C. § 102(b) and § 103(a), which cited Shelton as providing the basis for these rejections.

In the Final Office Action dated September 20, 2004, the Examiner acknowledged that Shelton does not teach the limitation that the first script and the first control and the second script and the second control are independent from Web pages that are displayed on the first computer and the second computer. See Final Office Action, pp. 3-4. Now, however, in the Office Action dated January 9, 2005, the Examiner cites Shelton as specifically teaching that limitation. Applicants respectfully submit once again that Shelton does not teach that the first script and the first control and the second script and the second control are independent from Web pages that are displayed on the first computer and the second computer. Should the Examiner persist in the position that Shelton teaches such a limitation, the Examiner is respectfully requested to identify, by identifying term and reference numeral as used in Shelton: which specific element in the Shelton reference the Examiner relies upon as corresponding to the first script; which specific element in the Shelton reference the Examiner relies upon as corresponding to the first control; which specific element in the Shelton reference the Examiner relies upon as corresponding to the second script; which specific element in the Shelton reference the Examiner relies upon as corresponding to the second control, and exactly where in the Shelton reference, by column and line, the Shelton reference teaches that the aforementioned four elements are independent from Web pages that are displayed on the first computer and second computer as claimed.

Specifically, it is respectfully submitted that to form a proper rejection, the Examiner must set forth with specificity the identity and location of each corresponding element alleged to be found in the prior art. In stark contrast, the examiner has cut-and-pasted the language of applicant's claims without specifically identifying, with specificity, which elements in Shelton the Examiner believes correspond to "the first script and the first control and the second script and the second control" and where Shelton teaches that these recited claim elements "are independent from Web pages that are displayed on the first computer and the second computer". Rather the cited portions relied upon by the Examiner relate generally to large portions of the Shelton specification that disclose numerous elements, rather than provide specific enumerations of where Shelton discloses each element of the limitation.

In citing Shelton, the Examiner merely states that the above-cited limitation may be found somewhere in the abstract; col. 4, lines 27-67, col. 5, lines 1-44; col. 7, lines 25-41; col. 11, lines 33-48 and col. 13, lines 1-19. Applicants have reviewed the entire Shelton reference, including these specified column and line numbers, but respectfully assert that this limitation is nowhere to be found in Shelton, either in the portions of the specification cited by the Examiner, or elsewhere. If the Examiner believes this limitation to be present in Shelton, Applicants respectfully request the Examiner specify precisely where each element of this limitation may be found.

Shelton is directed to a system for Internet synchronization that allows customers of a company to synchronize their browsers with customer service representatives ("agents") of the company. See Shelton Abstract and at col. 12, ln. 19 to col. 13 ln. 37. When a consumer visits a company's Web site, a session is created between the Web site

and the consumer's browser. See Shelton at col. 9, ins. 47-49. The company Web site includes Web pages having applets embedded therein, which are specifically enabled for synchronization. Shelton at col. 7, ins. 1-5. Synchronization is facilitated using synchronization applets. Contrary to the Examiner's contention, only enabled pages (i.e., pages having these embedded applets) can be synchronized. Shelton at col. 4 ln. 27 to col. 5 in. 45. An enabled Web page is not independent from the synchronization applets since the enabled Web page includes targets to the synchronization applets. Shelton at col. 7, ins. 1-5. In addition, the enabled Web page includes an individual Data Tracking and Synching (DTS) applet to monitor the user activities in each user input field.

In view of Shelton's disclosure that only enabled web pages can be synchronized, Applicants respectfully submit that Shelton does not and can not teach that the first script and the first control and the second script and the second control are independent from Web pages that are displayed on the first computer and the second computer. Therefore, the rejection of independent claims 1, 11, 23, 36, 49, 63, 73 and 74 and all claims depending therefrom, either directly or indirectly, pursuant to 35 U.S.C. § 103(a) should be withdrawn, and allowance thereof is respectfully requested.

The Examiner also bases the rejection of claims 1-2, 4-9, 11-12, 14, 16-21, 23, 30, 36-37, 39, 41-43, 45, 47-49, 56, 63-71, 73-75 and 77-83 on the fact that the Gavrilescu reference allegedly provides the missing elements recited in each independent claim, namely:

enabling the second computer to agree to synchronize with
the user first computer; and

enabling the user of the first computer to synchronize with
user of second computer

In view of the argument above that Shelton does not teach the limitation that “the first script and the first control and the second script and the second control are independent from Web pages that are displayed on the first computer and the second computer,” it is respectfully submitted that Gavrilesco also does not teach this limitation. Therefore, Gavrilesco does not overcome the deficiencies of Shelton and thus can not support the Examiner’s rejection.

The Examiner cites to portions of the Gavrilesco disclosure for providing the alleged teaching of the elements cited above as missing from Shelton. The Examiner bases the obviousness rejection on the alleged fact that “it would have been obvious to one of ordinary skill in the art to modify Shelton by allowing a first computer to synchronize with a second computer so that the information on the first computer is displayed in the browser of the second computer concurrently.” Prior to further discussion of the Gavrilesco reference *per se*, the following legal background is provided.

In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner, and thus the combination is improper. *See C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340,48 USPQ2d 1225 (Fed. Cir. 1998) (“the legal conclusion of obviousness requires that there be some suggestion, motivation or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and used them to make the new device”). Applicants further respectfully traverse the cited hypothetical combination of references on grounds that the proposed combination involves impermissible hindsight

reconstruction of the invention, involving “picking and choosing” from the teachings of multiple references. “Care must be taken to avoid hindsight reconstruction by using the application as a guide through the maze of prior art references combining the right references in the right way so as to achieve the result of the claims in suit.” *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988). Moreover, regarding hindsight reconstruction, the Federal Circuit has stated that, “virtually all [inventions] are combinations of old elements. Therefore, an Examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.” *Yamanouchi Pharmaceutical v. Danbury Pharmacal*, 231 F.3d 1339, 1343 (Fed. Cir. 2000) citing *In re Rouffet*, 149 F.3d 1350, 1357-58 (Fed. Cir. 1998).

A claim may be rendered obvious under 35 U.S.C. § 103 by combining the teachings of more than one reference only in the presence of a teaching, suggestion or incentive supporting the combination. *See e.g., Carella v. Starlight Archery*, 804 F.2d 135 (Fed. Cir. 1986). The mere fact that references *can* be combined or modified does not render the resulting combination obvious unless the prior art also *suggests the desirability* of the combination. *See* MPEP §2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Further, even if the cited references relied upon by the Examiner do in fact teach the individual components of the rejected claims, (a fact that is in no way

conceded in the present instance), that fact alone is also not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teaching of the references. Thus, the Examiner can satisfy this burden “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Lee*, 277 F.3d 1338, 1343, citing *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. based 1992). As *In re Lee* requires, as does *In re Zurko*, 258 F.3d 1379, 1383-86, the Examiner must set forth with specificity where the motivation exists in the cited references, or, if the Examiner is relying on general knowledge of the art, that general knowledge must be capable of readily documented substantiation. If the Examiner is relying on well-known facts or common knowledge in the art to provide the motivation, such facts and knowledge must be of a nature that are “capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03.A., citing *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970) (requiring that the notice of facts beyond the record which may be taken by the Examiner must be capable of instant and unquestionable demonstration so as to defy dispute).

The Applicants’ invention may not be used as the hindsight roadmap with which the Examiner winds his way through the prior art for identifying features and then, using the teachings of the claimed invention, “use that which the inventor has taught against its teacher” to provide the missing motivation to combine the references to yield the claimed invention. *In re Lee*, 277 F.3d 1338, 1344, citing *WL. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1993). As the Federal Circuit stated in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *See e.g., C.R. Bard, Inc. v. M3 Sys.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1998) (evidence of teaching or suggestion “essential” to avoid hindsight)... Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability — the essence of hindsight. *See e.g., Interconnect Planning Corp., v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”)

Thus, in accordance with the legal basis set forth above, in order for an obviousness rejection to stand there must be a teaching or suggestion in the references themselves to make the combination made by the Examiner, and, importantly, the combination, even if proper, must when made, recite each and every limitation of the claims being rejected. The mere fact that references appear as analogous art is not sufficient to sustain an obviousness rejection. *See e.g. Lee, Mills, Zurko, supra.* Gavrilesco nowhere describes how one should adapt Shelton, which requires specially modified web-pages containing embedded code, to operate without such embedded code, nor does Shelton suggest the desirability of such feature, as Shelton exclusively teaches the use of embedded code in

web pages. Thus the combination of Shelton and Gavrilesu cannot form the basis of a proper §103 rejection.

It is further respectfully submitted that in addition to the fact that neither the Shelton nor the Gavrilesu reference provides any motivation for combining these references, Gavrilesu does not recite, teach or suggest the element admittedly missing from Shelton. Thus, even if the Examiner's combination of Shelton and Gavrilesu were proper, (which it is respectfully submitted such combination is not), such combination would not yield that the claimed invention as the Gavrilesu reference fails to provide the element which the Examiner has admitted is missing from Shelton.

Gavrilesu is directed to a method for co-browsing web sites by two or more users. In a co-browsing session between a first client of a first user and a second client of a second user, the first user initiates a co-browsing session, and browses a web site on the first client. Gavrilesu, ¶¶ 0027-0029. The first client sends a synchronization message to the second client indicating one or more commands reflecting the browsing performed by the first user. *Id.* The second client receives the synchronization message, and co-browses the web site in accordance with the message and its included commands. *Id.* Co-browsing continues until the co-browsing session is terminated. The first user may transfer control of the co-browsing session to the second user. Gavrilesu, ¶ 0028.

Gavrilesu does not teach or suggest the limitation that a first script and a first control and a second script and a second control are independent from Web pages that are displayed on the first computer and the second computer. Accordingly, applicant respectfully submits that the proposed hypothetical combination of Shelton and

Gavrilescu, assuming *arguendo* such a combination were proper, does not disclose all of the features of independent claims 1, 11, 23, 36, 49, 63, 73 and 74 of the present application. *See, e.g., Texas Instruments v. United States ITC*, 988 F.2d 1165, 26 USPQ2d 1018 (Fed. Cir. 1993). Therefore applicant respectfully traverses Examiner's contention that claims 1, 11, 23, 36, 49, 63, 73 and 74 are unpatentable over Shelton in view of Gavrilescu.

Dependent claims 2, 4-9, 12, 14, 16-21, 30, 37, 39, 41-43, 45, 47-48, 56, 64-71, 73, 75 and 77-83 depend either directly or indirectly from one of claims 1, 11, 23, 36, 49, 63 and 74. Gavrilescu does not teach or suggest the claimed features absent from Shelton as described above. Accordingly, applicant respectfully submit that the proposed hypothetical combination of Shelton and Gavrilescu, assuming *arguendo* such a combination were proper, does not disclose all of the features of claims 2, 4-9, 12, 14, 16-21, 30, 37, 39, 41-43, 45, 47-48, 56, 64-71, 73, 75 and 77-83 of the present application. *See, e.g., Texas, supra*. Therefore applicant respectfully traverses Examiner's contention that claims 2, 4-9, 12, 14, 16-21, 30, 37, 39, 41-43, 45, 47-48, 56, 64-71, 73, 75 and 77-83 are unpatentable over Shelton in view of Gavrilescu.

Claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Gavrilescu and further in view of U.S. Publication No. 2002/0083134 ("Bauer"). Applicants respectfully traverse this rejection based on the following reasons.

As discussed above, independent claims 1, 11, 23, 36, 49, 63 and 74 of the present application, claim, *inter alia*, a system or method comprising controlling the Internet

navigation of a second computer based upon the Internet navigation of a first computer, wherein a first script and a first control and a second script and a second control are independent from Web pages that are displayed on a first computer and a second computer. Also, as discussed above, neither Shelton nor Gavrilesescu teaches or discloses all of the features of independent claims 1, 11, 23, 36, 49, 63 and 74. Dependent claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84 depend either directly or indirectly from one of claims 1, 11, 23, 36, 49, 63 and 74. Bauer does not teach or suggest the claimed features absent from Shelton as described above. Accordingly, applicant respectfully submit that the proposed hypothetical combination of Shelton, Gavrilesescu and Bauer, assuming *arguendo* such a combination were proper, does not disclose all of the features of claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84 of the present application. See, e.g., *Texas, supra*. Therefore applicant respectfully traverses Examiner's contention that claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84 are unpatentable over Shelton in view of Gavrilesescu and further in view of Bauer.

Accordingly, applicant respectfully submits that a proposed hypothetical combination of Shelton, Gavrilesescu and Bauer would not result in all of the features of claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84. In addition there is there no motivation, either explicit or implicit, to combine Shelton, Gavrilesescu and Bauer. Therefore, applicant submits that claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84 are patentable over the proposed hypothetical combination of Shelton, Gavrilesescu and Bauer and respectfully requests withdrawal of the rejection of those claims.

Claims 3, 13, 15, 25-28, 31, 33, 40, 46, 51-55, 57, 61 and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Gavrilesescu and further

in view of U.S. Publication No. 2002/0035603 ("Lee"). Applicants respectfully traverse this rejection based on the following reasons.

As discussed above, neither Shelton nor Gavrilesu discloses all of the features of claims 1, 11, 23, 36, 49 and 74, as amended. Dependent claims 3, 13, 15, 25-28, 31, 33, 40, 46, 51-55, 57, 61 and 76 depend either directly or indirectly from one of claims 1, 11, 23, 36, 49 and 74, as amended. Lee does not teach or suggest the claimed features absent from Shelton as described above. Accordingly, applicant respectfully submits that the proposed hypothetical combination of Shelton and Lee does not disclose all of the features of claims 3, 13, 15, 25-28, 31, 33, 40, 46, 51-55, 57, 61 and 76 of the present application. *See, e.g., Texas, supra.* Therefore applicant respectfully traverses the Examiner's contention that claims 3, 13, 15, 25-28, 31, 33, 40, 46, 51-55, 57, 61 and 76 are unpatentable over Shelton in view of Gavrilesu, and further in view of Lee.

Accordingly, applicant respectfully submits that a proposed hypothetical combination of Shelton, Gavrilesu and Lee would not result in all of the features of claims 3, 13, 15, 25-28, 31, 33, 40, 46, 51-55, 57, 61 and 76. Therefore, applicant submit that claims 3, 13, 15, 25-28, 31, 33, 40, 46, 51-55, 57, 61 and 76 are patentable over the proposed hypothetical combination of Shelton, Gavrilesu and Lee and respectfully requests withdrawal of the rejection of those claims.

Claims 29, 35 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Gavrilesu and further in view of Lee. Applicants respectfully traverse this rejection based on the following reasons.

As discussed above, neither Shelton nor Gavrilesu discloses all of the features of claims 1, 11, 23, 36, 49 and 74, as amended. Dependent claims 29, 35 and 59 depend either directly or indirectly from one of claims 1, 11, 23, 36, 49 and 74. Lee does not teach or suggest the claimed features absent from Shelton and Gavrilesu as described above. Accordingly, applicants respectfully submit that the proposed hypothetical combination of Shelton, Gavrilesu and Lee does not disclose all of the features of claims 29, 35 and 59 of the present application. *See, e.g., Texas, supra.* Therefore applicants respectfully traverse the Examiner's contention that claims 29, 35 and 59 are unpatentable over Shelton in view of Gavrilesu and further in view of Lee.

Accordingly, applicant respectfully submits that a proposed hypothetical combination of Shelton, Gavrilesu and Lee would not result in all of the features of claims 29, 35 and 59. Therefore, applicant submit that claims 29, 35 and 59 are patentable over the proposed hypothetical combination of Shelton, Gavrilesu and Lee and respectfully requests withdrawal of the rejection of those claims.

Conclusion

Applicants have considered the prior art of record, and respectfully submit that none of the references relied upon by the Examiner in rejecting the claims of the present application, considered alone or in any hypothetical combination (between and among each other or with the knowledge of a person of ordinary skill in the art), teach or suggest applicant's invention, as recited by the claims of the present application.

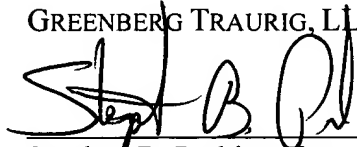
Applicants respectfully request reconsideration of the present application in view of the remarks provided herein. If the Examiner is not in a position to allow all claims as

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presently amended, the Examiner is urged to call the undersigned attorney at 303-572-6500. Any additional fees or charges required at this time or in the future in connection with the present application are hereby authorized to be charged to Deposit Account No. 502775.

Respectfully submitted this 9th day of June, 2005.

GREENBERG TRAURIG, LLP

A handwritten signature in black ink, appearing to read "Stephen B. Perkins", is written over a horizontal line.

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